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10/629,295	07/29/2003	Douglas Carl Bacon	132843	6494

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EXAMINER

JOSEPH, TONYA S

ART UNIT	PAPER NUMBER
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3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/629,295	Applicant(s) BACON ET AL.	
	Examiner Tonya Joseph	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/10/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

1. Applicant's election with traverse of Group II, claims 10-27, in the reply filed on 12/13/2006 is acknowledged. The traversal is on the ground(s) that Groups I and II are clearly related. This is not found persuasive because the inventions are distinct, each from the other because of the following reasons: Inventions 1 and 2 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process of product can be used to perform a process for a diesel generator or various engine types.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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4. Claim 10 recites the limitation, "receive, at a database, component operational history data" in line 7. It is unclear whether this is the centralized database or another database. For Examination purposes Examiner is interpreting "a database" to be the same as the centralized database.
5. Claims 16 and 25 recite the limitation, the inputted gas component frame size and combustion type" in line 8. There is insufficient antecedent basis for this limitation in the claim.
6. Claims 11-15 and 17-18 contain the same deficiencies as claim 1 through dependency and as such, are rejected for the same reasons.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 10-11, 13-14, 18-20, 22-23 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Gonyea et al. U.S. Pre-Grant Publication No. 2001/0032109 A1.
9. As per Claim 10, Gonyea teaches a client system (see para. 13 lines 1-6, para. 14 lines 1-5 and Fig. 1; a centralized database for storing information (see

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para. 13 lines 13-17 and Fig. 1); a server system configured to be coupled to said client system and said database said server system (see para. 13 lines 6-17, para. 19 lines 1-4 and Fig. 1) further configured to: receive, at a database, component operational history data and component inspection data from a user for a pre-identified component (see para. 46 lines 6-8 and para. 31 lines 6-10, para. 21 lines 1-13 and para. 26 lines 8-10); receive, at the database, component replacement part costs, component part repair costs, and vendor service costs associated with the pre-identified component (see para. 22 lines 8-13 and para. 44); prompt a user to input a pre-determined component operational forecast into the database (see para. 26 lines 6-10 and Fig. 5); analyze component maintenance information including at least one of component operational history data, component inspection data, replacement part costs, part repair costs, vendor service costs, and component operational forecast (see para. 27 lines 9-26); and automatically generate a financial report including at least one schedule of component maintenance events and costs associated with each event based on the component maintenance information analysis (see para. 24 lines 12-20).

10. As per Claim 11, Gonyea teaches the system of claim 10 as described above. Gonyea further teaches said server system is configured to receive component replacement part costs, component part repair costs, and vendor service costs associated with the identified component from an on-line catalog selected based on the component identification (see para. 17 lines 4-7; para. 19 lines 4-9; para. 22 lines 3-13 and para. 44, Examiner is interpreting a listed item

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on the parts list as an identified component. Examiner is further interpreting an online database having lists and files relating to parts list detail as an online catalog).

11. As per Claim 13, Gonyea teaches the system of claim 10 as described above. Gonyea further teaches, said server system is configured to compute a schedule for maintenance events based on at least one of estimated life of replacement parts, estimated life of repaired parts, component operational history, component operational forecast and a predetermined maintenance event interval (see para. 27 lines 9-16 and para. 31).

12. As per Claim 14, Gonyea teaches the system of claim 13 as described above. Gonyea further teaches said server system is configured to determine a part repair cycle (see para. 27 lines 27-37).

13. As per Claim 18, Gonyea teaches the system of claim 10 as described above. Gonyea further teaches said server system is configured to automatically compute the financial charges accrued during the maintenance event using the component replacement part costs, the component part repair costs, and the vendor service costs associated with the maintenance event (see para. 24 lines 12-20 and para. 22 lines 8-13).

14. As per Claim 19, Gonyea teaches, a computer program embodied on a computer readable medium for maintaining at least one component, said program comprising a code segment that receives, at a database, component operational history data and component inspection data from a user for a pre-identified component and (see para. 60 and para. 46 lines 6-8 and para. 31 lines

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6-10): receives, at the database, component replacement part costs, component part repair costs, and vendor service costs associated with the pre-identified component (see para. 22 lines 8-13 and para. 44); prompts a user to input a pre-determined component operational forecast into the database (see para. 26 lines 6-10 and Fig. 5); analyzes component maintenance information including at least one of component operational history data, component inspection data, replacement part costs, part repair costs, vendor service costs, and component operational forecast and (see para. 27 lines 9-26); automatically generates a financial report including at least one schedule of component maintenance events and costs associated with each event based on the component maintenance information analysis (see para. 60 and para. 24 lines 12-20).

15. As per Claim 20, Gonyea teaches the computer readable medium of claim 10 as described above. Gonyea further teaches said program comprising a code segment that receives component replacement part costs, component part repair costs, and vendor service costs associated with the identified component from an on-line catalog selected based on the component identification (see para. 60 and see para. 17 lines 4-7; para. 19 lines 4-9; para. 22 lines 3-13 and para. 44, Examiner is interpreting a listed item on the parts list as an identified component.. Examiner is further interpreting an online database having lists and files relating to parts list detail as an online catalog).

16. As per Claim 22, Gonyea teaches the computer readable medium of claim 19 as described above. Gonyea further teaches said program comprising a code segment that computes a schedule for maintenance events based on at least

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one of estimated life of replacement parts, estimated life of repaired parts, component operational history, component operational forecast and predetermined maintenance event interval (see para. 60 and para. 27 lines 9-16 and para. 31).

17. As per Claim 23, Gonyea teaches the computer readable medium of claim 22 as described above. Gonyea further teaches said program comprising a code segment that determines a part repair cycle (see para. 60 and para. 27 lines 27-37).

18. As per Claim 27, Gonyea teaches the computer readable medium of claim 19 as described above. Gonyea further teaches said server system is configured to automatically compute the financial charges accrued during the maintenance event using the component replacement part costs, the component part repair costs, and the vendor service costs associated with the maintenance event (see para. 60 and para. 24 lines 12-20 and para. 22 lines 8-13).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 12, 15-16, 21 and 24-25 are rejected under 35 U.S.C. 103(a) as being anticipated by Gonyea et al. U.S. Pre-Grant Publication No. 2001/0032109 A1 in view of Official Notice.

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21. As per Claim 12, Gonyea teaches the system of claim 10 as described above. Gonyea further teaches said server system is configured to: determine component maintenance event contingency fees (see para. 24 lines 12-20, Examiner is interpreting service costs as contingency fees); Gonyea does not explicitly teach, determine customer cost discount level for replacement parts and vendor fees. Official Notice is taken that determining a discount to a customer for replacement costs and vendor fees is old and well known in the art of service contract bidding. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Gonyea to include determining customer cost discount level for replacement parts and vendor fees in order to provide an incentive to a potential client to use the services of a vendor.

22. As per Claim 15, Gonyea teaches the system of claim 10 as described above. Gonyea further teaches an age of a plurality of parts installed in a component (see para. 20 lines 6-9 and lines 3-5) an age of the component parts in inventory (see para. 27 lines 9-14, Examiner is interpreting a part that has been removed from a component, repaired and then returned to inventory as having a known age). Gonyea does not explicitly teach a user being prompted to input age of a plurality of parts installer in a component and an age of the component parts in inventory. Official Notice is taken that prompting a user to enter data is old and well known in the art of database management. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Gonyea to include prompting a user to input an

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age of a plurality of parts installer in a component and an age of the component parts in inventory in order enable a user to keep an accurate record of costs and expenditures. Gonyea further teaches, determines, from the schedule of maintenance events, the age of each of the plurality of installed parts and the age of each of the plurality of inventory parts at each maintenance event (see para. 27 lines 9-22 and para. 57 lines 4-9); and displays an identification of each part whose age at each scheduled maintenance event exceeds a pre-determined age (see para. 27 lines 27-37 and para. 28 lines 13-21).

23. As per Claim 16, Gonyea in view of Official Notice teaches the system of Gonyea as described above. Gonyea further teaches access a predetermined on-line catalog, the catalog including new parts costs and parts repair costs and part expected life (see para. 17 lines 4-7 and para. 19 lines 5-9, para. 22 lines 8-13; para. 24 lines 6-10; para. 27 lines 5-7 and para. 28 lines 5-12, Examiner is interpreting the accessing of an online catalog and corresponding parts information to be based on the exact maintenance event as described in para. 28 lines 6-10), Gonyea does not explicitly teach accessing a predetermined on-line catalog using the frame size and combustion type.

However, these differences are only found to be non-functional descriptive material and are not functionally involved in the steps recited. The accessing of the identified data would be the same regardless of the type of identification used to find it. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381,

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1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Gonyea further teaches recommend an inspection interval and an estimate of remaining parts life (see para. 35 lines 9-10 and para. 27 lines 4-7, Examiner is interpreting the recommendation to be based on contract information as described in para. 31 lines 6-10) Gonyea does not explicitly teach recommending an inspection interval and an estimate of remaining parts life based on the inputted gas component frame size and combustion type. However, these differences are only found to be non-functional descriptive material and are not functionally involved in the steps recited. The recommended inspection interval and the estimate of remaining parts life would be the same regardless of the type of identification used to find the already computed information. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

24. As per Claim 21, Gonyea teaches the computer readable medium of claim 19 as described above. Gonyea further teaches said program comprising a code segment that: determines component maintenance event contingency fees (see para. 60 and para. 24 lines 12-20; Examiner is interpreting service costs as contingency fees); Gonyea does not explicitly teach, determine customer cost discount level for replacement parts and vendor fees. Official Notice is taken that determining a discount to a customer for replacement costs and vendor fees is

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old and well known in the art of service contract bidding. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Gonyea to include determining customer cost discount level for replacement parts and vendor fees in order to provide an incentive to a potential client to use the services of a vendor.

25. As per Claim 24, Gonyea further teaches, the computer readable medium of claim 19 as described above. Gonyea further teaches said program comprising a code segment that: an age of a plurality of parts installed in the component (see para. 20 lines 6-9 and lines 3-5); an age of the component parts in inventory(see para. 27 lines 9-14, Examiner is interpreting a part that has been removed from a component, repaired and then returned to inventory as having a known age); Gonyea does not explicitly teach a user being prompted to input this data. Official Notice is taken that prompting a user to enter data is old and well known in the art of database management. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Gonyea to include prompting a user to input an age of a plurality of parts installer in a component and an age of the component parts in inventory in order to keep an accurate record of costs and expenditures. Gonyea further teaches determines, from the schedule of maintenance events, the age of each of the plurality of installed parts and the age of each of the plurality of inventory parts at each maintenance event(see para. 27 lines 9-22 and para. 57 lines 4-9); and displays an identification of each part whose age at each scheduled

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maintenance event exceeds a pre-determined age (see para. 27 lines 27-37 and para. 28 lines 13-21).

26. As per Claim 25, Gonyea in view of Official Notice teaches the computer readable medium of claim 19 as described above. Gonyea further teaches said program comprising a code segment that (see para. 60): access a predetermined on-line catalog, the catalog including new parts costs and parts repair costs and part expected life (see para. 17 lines 4-7 and para. 19 lines 5-9, para. 22 lines 8-13; para. 24 lines 6-10; para. 27 lines 5-7 and para. 28 lines 5-12, Examiner is interpreting the accessing of an online catalog and corresponding parts information to be based on the exact maintenance event as described in para. 28 lines 6-10), Gonyea does not explicitly teach accessing a predetermined on-line catalog using the frame size and combustion type.

However, these differences are only found to be non-functional descriptive material and are not functionally involved in the steps recited. The accessing of the identified data would be the same regardless of the type of identification used to find it. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Gonyea further teaches recommend an inspection interval and an estimate of remaining parts life (see para. 35 lines 9-10 and para. 27 lines 4-7, Examiner is interpreting the recommendation to be based on contract information as described in para. 31 lines 6-10) Gonyea does not explicitly teach

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recommending an inspection interval and an estimate of remaining parts life based on the inputted gas component frame size and combustion type. However, these differences are only found to be non-functional descriptive material and are not functionally involved in the steps recited. The recommended inspection interval and the estimate of remaining parts life would be the same regardless of the type of identification used to find the already computed information. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

27. Claims 17 and 26 are rejected under 35 U.S.C. 103(a) as being anticipated by Gonyea et al. U.S. Pre-Grant Publication No. 2001/0032109 A1.

28. As per Claim 17, Gonyea teaches the system of claim 10 as described above. Gonyea further teaches remove selected parts from an inventory (see para. 55 lines 2-7 and para. 56 lines 5-9); repair the component using the selected parts (see para. 57 lines 1-5); automatically orders replacement parts for purchase (see para. 57 lines 11-12) and replenish the inventory using the replacement parts (see para. 57 lines 12-14). Gonyea does not explicitly teach said server system is configured to: automatically compute a projected rotation of component parts through a fleet of components. However, Gonyea discloses an automatic computation of a projected rotation of component parts through a component (see para. 55, 56 and 57). Therefore, it would have

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been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Gonyea to include automatically compute a projected rotation of component parts through a fleet of components in order to accomplish the desired effect for multiple components.

29. As per Claim 26, Gonyea teaches the computer readable medium of claim 19. Gonyea further teaches said program comprising a code segment that (see para. 60); removes selected parts from an inventory (see para. 55 lines 2-7 and para. 56 lines 5-9); repairs the component using the selected parts (see para. 57 lines 1-5); automatically orders replacement parts for purchase (see para. 57 lines 11-12); and replenishes the inventory using the replacement parts (see para. 57 lines 12-14). Gonyea does not explicitly teach said server system is configured to: automatically compute a projected rotation of component parts through a fleet of components. However, Gonyea discloses an automatic computation of a projected rotation of component parts through a component (see para. 55, 56 and 57). Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Gonyea to include automatically compute a projected rotation of component parts through a fleet of components in order to accomplish the desired effect for multiple components.

Conclusion

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tonya Joseph whose telephone number is

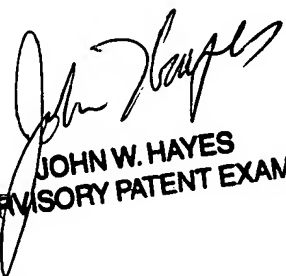
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571-270-1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tonya Joseph
Examiner
Art Unit 3628


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER